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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,991	06/22/2006	Mitsuyoshi Kuwahata	062705	7383

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EXAMINER	
TESKIN, FRED M	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
04/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/583,991	KUWAHATA ET AL.	
	Examiner	Art Unit	
	Fred M. Teskin	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 January 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20080128*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

This Office action follows a reply filed on January 28, 2008, in response to the Notice of Non-Responsive Reply mailed December 28, 2007. Amendments presented in said reply are acknowledged. Claims 1 and 4-6 are currently pending and under examination.

Claim 1 having been amended to include the limitations of claim 3, indicated as allowable in the prior Office action, the prior art rejections over JP '003 and JP '810 have been obviated. However, upon further consideration, new grounds of rejection are made as detailed below.

Claims 1 and 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 4-6 are indefinite due to claim 1 being internally inconsistent with respect to the scope and nature of products obtained by the recited copolymerizing of monomer (A) and macromonomer (B). Note that selection of vinyl acetate as monomer (A) would result in a copolymer devoid of chlorine, which conflicts with the description of the claimed product as "... vinyl *chloride* copolymer resin" (claim 1, line 1; claim 6, line 2). The inconsistency leads to a lack of clarity as to whether a chloride entity is an essential or optional constituent of the product and composition of the claimed invention. Clarification and appropriate correction are required.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,354,970. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ merely in matters of scope and/or semantics. In particular, present claims 1 and 4 are drawn to a soft vinyl chloride copolymer resin obtained by copolymerizing (A) a monomer comprising vinyl chloride, vinylidene chloride or vinyl acetate and (B) a macromonomer having a polymer comprising an ethylenically unsaturated monomer containing a double bond in a main chain, wherein the ratio of (A)/(B) is defined by a weight range inclusive of 80/20 and wherein the macromonomer is prepared by living radical polymerization. The patent claims literally read on a polyvinyl chloride copolymer resin comprising a copolymer containing 80

percent by weight of a vinyl chloride monomer and 20 percent by weight of a macromonomer having a vinyl polymer main chain, prepared by living radical polymerization (*cf.*, claims 1, 2 and 18 of '970 with claim 1 hereof). The "soft" property recited in present claim 1 is reasonably presumed inherent in the patented resin comprising an identical copolymer composition. Similarly, present claim 6 being drawn broadly to a soft vinyl chloride resin composition comprising the soft vinyl chloride copolymer resin of claim 1, is readable on the patented plastisol, comprising a copolymer which can likewise contain 80 percent by weight of vinyl chloride monomer and 20 percent by weight of macromonomer having a vinyl polymer main chain (see claims 1 and 12 of '970).

Claims 1 and 4-6 are deemed free of the prior art. Examiner has not, as of the date of this Office action, located or identified any prior art documents that can be used to render the applicants' soft vinyl chloride copolymer resin as presently claimed anticipated or obvious to a person of ordinary skill in the art.

In view of the new grounds of rejection, this action is made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred M Teskin/

Primary Examiner, Art Unit 1796